

Remarks

Upon entry of the foregoing amendment, claims 1-78 are canceled and claims 79-104 are pending in the application, with claims 79 and 92 being the independent claims.

Support for the new claims can be found, *inter alia*, in the specification at page 12, lines 13-30; page 14, lines 5-9 and at page 14, line 30 through page 15, line 3. Therefore the new claims do not introduce new matter.

I. Claim Objections.

Claims 72-74 and 76-78 have been objected to by the Examiner under 37 C.F.R. § 1.75(c) as being of improper dependent form and for failing to further limit the claim matter. (Office Action, page 2.) Claims 72-74 and 76-78 are canceled herein rendering the objection moot. Applicants believe that new claims 79-104 are in compliance with 37 C.F.R. § 1.75(c).

II. Claim Rejection Under 35 U.S.C. § 112, Second Paragraph.

Claims 52-59 and 61-78 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. (Office Action, page 3.) Applicants respectfully disagree but have replaced the claims solely to expedite prosecution.

The Examiner alleges that the term “site-specific recombination site” is vague and indefinite because the metes and bounds of a “site-specific recombination site” are unclear. Applicants believe that a “site-specific recombination site” is well defined in the specification and in the art. For example, see page 1, line 26 through page, 4 line 10 of the specification. However, to expedite prosecution, new claims 79-104 recite the term “*lox* or *att* site.”

The Examiner also alleges that the phrase “said linear nucleic acid molecule” recited in step (c) of claim 52 lacks proper antecedent basis. (Office Action, page 4.) New claims 79-104 do not recite a step (c) referring to a linear nucleic molecule, therefore this basis of rejection has been rendered moot.

In view of these amendments and remarks, Applicants believe that new claims 79-104 are in compliance with 35 U.S.C. § 112, second paragraph and respectfully request that the Examiner reconsider and withdraw the rejection.

III. Claim Rejection Under 35 U.S.C. § 112, First Paragraph.

Claims 52-59, 61-68 and 71-78 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. (Office Action, page 5.) Applicants respectfully disagree but have amended the claims solely to expedite prosecution.

The Examiner alleges that the specification does not provide sufficient blazemarks or direction for the term “site-specific recombination sites.” (Office Action, page 5.) As noted above, the claims have been amended to recite “*lox* or *att* sites.” In view of these amendments, Applicants believe that new claims 79-104 are in compliance with 35 U.S.C. § 112, first paragraph and respectfully request reconsideration and withdrawal of the rejection.

IV. Claim Rejection Under 35 U.S.C. §§ 102(a) and (e).

Claims 71 and 75 stand rejected under 35 U.S.C. §§ 102(a) and (e) as being anticipated by Auerbach (U.S. patent No. 5,614,389). (Office Action, page 6.) Applicants respectfully disagree but have replaced the claims solely to expedite prosecution.

The Examiner states “[f]or the purposes of this rejection only, Examiner has interpreted site-specific recombination site to include any nucleic acid sequence purposely engineered such that recombination may occur at that site, including through the use of restriction enzymes sites, sites of DNA repair proteins and or sites of DNA homologous recombination.” (Office Action, page 6.) As an initial matter, Applicants note that a claim term has only one meaning, regardless of under which section of patent law it is being evaluated. As noted above, the meaning of the term site-specific recombination is discussed in the specification. The Examiner may not use a definition of a claim term that conflicts with the definition provided in the specification. (*See Manual of Patent Examining Procedure (MPEP) § 2111.01 (eighth edition, revision 5, August 2006).*) The pending claims now recite “*lox* and *att* sites,” therefore Applicants believe that new claims 79-104 are not anticipated by the cited references and respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102.

Claims 52, 56, and 61-66 stand rejected under 35 U.S.C. § 102 as being anticipated by Elledge *et al.* (U.S. Patent No. 5,851,808). (Office Action, page 8.) Applicants respectfully disagree but have replaced the claims solely to expedite prosecution.

New independent claims 79 and 92 are directed, in part, to a nucleic acid molecule being contacted with a topoisomerase. Elledge *et al.* does not disclose the use of topoisomerases, therefore Elledge *et al.* does not teach all the elements of the claims and does not anticipate the claims. Applicants believe that new claims 79-104 are in compliance with 35 U.S.C. § 102 and respectfully request reconsideration and withdrawal of the rejection.

Conclusion

All of the stated grounds of rejection have been properly traversed. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

/Peter G. Foiles/

Peter G. Foiles
Agent for Applicants
(240) 379-4173
Registration. No. 46,477

Date: April 3, 2007